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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,244	11/28/2001	Daniel Richard Schaefer	594826-001	3771

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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 05/08/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/996,244	Applicant(s) SCHAFFER	
	Examiner Rick Palabrica	Art Unit 3663	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 22 January 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.

Continuation of 10. Other (including any explanation in support of the above items):

This Office action replaces the 5/8/2007 Office action that is withdrawn. Per instruction to the appellant by Mr. Jack Keith, on May 23, 2007, in correcting the deficiencies noted by the examiner hereinunder, appellant shall use only the language in the claims and the specification and specifically delete the reference to "embodiment" when discussing what a claim is directed to. Failure to follow the said instructions from Mr. Keith will be considered NOT inadvertent error.

The reply filed on 1/22/07 is still not fully responsive to the prior Office Action because: contrary to the 11/3/06 Notice of Non-compliance with 37 CFR 1.192(c), appellant has not corrected the deficiencies in said Notice. The appellant has also not corrected some of the deficiencies cited in the 1/04/05 and 2/16/05 Notices of Non-compliance.

As to the deficiencies in the 1/22/07 Appeal Brief that were identified in the 11/3/06 Notice, appellant has still not corrected the: a) inaccuracy in the Summary of Invention, and b) impropriety of the arguments regarding the 35 U.S.C. 112, second paragraph rejection of the claims.

As to item a), Summary of Invention (Section V) in the 1/22/07 Appeal Brief, states:

"After the spectrographical analysis and "stripping" away of the interfering gamma ray emission counts, the presence of a pure beta emitter in the fullerene was seen (page 9, lines 18-20." Underlining provided.

This is still inaccurate. Firstly, the cited part of the specification neither uses nor refers to the term, "seen." Secondly, the term, "seen" means "an act or state of having found or observed something." Based on appellant's specification, he did not find or observe that neutrons can be trapped inside a fullerene molecule but rather ONLY INFERRED or SURMISED such trapping based on an alleged presence of a pure beta emitter, as evidenced by the following statement:
"Evidence that neutrons are trapped in the fullerene molecules consists of the presence of a pure beta emitter in the fullerene that remains after the counts resulting from the gamma emitters have been stripped from the raw data. The pure beta emitter has a half life anywhere near ten minutes. There are very few pure beta particle emitters with a half life anywhere near ten minutes. The rarity of these pure beta emitters, their chemical nature, and the chemical nature of the fullerene all point to the conclusion that they cannot be the source of the pure beta emitter observed in the irradiated fullerene. The only other possible source of the radiation is the decay of free neutrons." see page 7, lines 18+ of the specification.

As to item b), the deficiencies in appellant's arguments, which were cited in the 11/03/06 Notice, still have not been corrected in the 1/22/07 Appeal Brief. (The same deficiencies were also previously cited separately in 1/04/05 Notice and in the 2/16/05 Notice). Appellant's arguments are still defective because are based on features that are neither in the claims nor in the specification. For example, appellant argues that each of the claims 4-8, 10-14 and 16-19 is directed to a specific embodiment or particular property, but neither one has a basis in the disclosure.

For instance, appellant states:

"Claim 4 is directed to the embodiment in which the trapped neutron is defined as being in an accelerated state characterized by higher energy levels." Underlining provided.

An embodiment, which is equivalent to a species, is a suitable alternative (by itself alone) for exercising the claimed invention (see MPEP 806.04(e)). However, there is no mention at all in the specification that such acceleration of neutrons inside a fullerene molecule is an "embodiment" of the claimed invention.

In another instance, appellant states:

"Claim 7 is directed to the embodiment wherein the free thermal neutrons have the property that they are useful as an irradiation target for bombardment by other particles. Underlining provided.

Again, there is no mention of such embodiment or species in the specification. Also, there is no disclosure of what is this so-called property that makes it useful for the alleged purpose.

Additionally, each of claims 4-8, 10-14 and 16-19 is recited as being directed to an embodiment. If such is an accurate representation of the claims, which is not the case, then there are fourteen (14) embodiments of the claimed invention. Some or all of these embodiments (or species) would be distinct, and the examiner would have subjected the original application to an election of species requirement, as per MPEP 806.04(f). No such restriction was issued because said 14 claims are not directed to 14 separate embodiments.

The presentation and discussion regarding "repetitive sample experiments" and testing of "irradiated fullerene samples" at page 14 of the 1/22/07 Appeal Brief, have previously been cited as defective in 1/04/05 Notice and in the 2/16/05 Notice because they represent new evidence. This deficiency continues to exist in the 1/22/07 Appeal Brief.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick Palabrica whose telephone number is 571-272-6880. The examiner can normally be reached on 6:00-4:30, Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RJP
May 24, 2007


RICARDO J. PALABRICA
PRIMARY EXAMINER